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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/398,377	09/17/1999	STEVEN P. BITLER	12969	1011

7590 02/09/2005

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EXAMINER

SZEKELY, PETER A

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 02/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	09/398,377		BITLER, STEVEN P.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Peter Szekely		1714	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 November 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 40,41,44,46,47,51,59-73,77,78,80,81 and 83-129 is/are pending in the application.
- 4a) Of the above claim(s) 121-129 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 40,41,44,46,51,59-64,73,77,80,82-89,91,100-108,120 and 6868 is/are allowed.
- 6) ☒ Claim(s) 78,81,92-99 and 110-118 is/are rejected.
- 7) ☒ Claim(s) 65,90 and 109 is/are objected to.
- 8) ☒ Claim(s) 121-129 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>11/29/04</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Specification***

1. The amendment filed 11/29/04 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: From page 3, line 23, to page 3, line 26 of the "REPLY" submitted 11/29/04. The original specification does not mention the Food, Drug and Cosmetic Act and it redefines "cosmetic materials" in a manner not originally envisaged in the specification.

Applicant is required to cancel the new matter in the reply to this Office Action.

### ***Allowable Subject Matter***

2. Claims 40, 41, 44, 46, 47, 49, 51, 59-64, 68-73, 77, 80, 83-89, 91, 100-108 and 120 are allowed.

### ***Claim Objections***

3. Claims 65-67 are objected to as being of improper dependent since they are broader than the claim they depend from. There are no vegetable oils or glycol ethers or silicones etc. in claim 59. Claim 90 is objected to because it depends from a canceled claim. Claim 109 is objected to since it does further limit claim 101.

### ***Election/Restrictions***

4. Newly submitted claims 121-129 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The new claims are directed to a method of coating a substrate classified in class 427, while the

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original claims are directed to a composition classified in class 524. Searching in the additional class would place an undue burden on the examiner.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 121-129 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

***Claim Rejections - 35 USC § 102***

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 110-119 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over McCoy et al. 3,894,958, Song et al. 3,892,671 or Kaneshige et al. 4,877,577.

7. McCoy et al. disclose oil, polymethacrylate thickeners and silicone in column 6, lines 27-63. Song et al teach oil and (meth)acrylic pour point depressants in column 2, lines 27-63, polymer concentrations in column 4, lines 2-7 and dyes in column 4, line 29. Kaneshige et al. recite polymethacrylic acid ester viscosity agents improvers, polyalkylmethacrylate pour point depressants, dimethyl polysiloxane, colorant and concentrations in synthetic hydrocarbon oil in column 7, lines 52-68. All properties are inherent in the composition. Applicants' claims are not novel. In the alternative, it would have been obvious to one having ordinary skill in the art, at the time the invention was made, to select colorants and silicones from a list of equivalents.

***Claim Rejections - 35 USC § 103***

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

9. Claims 78, 81 and 92-99 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCoy et al. 3,894,958, Song et al. 3,892,671 or Kaneshige et al. 4,877,557, in view of Honda Motor Co. JP-59-185813 or Hitachi Cable LTD. JP-07-220531.

10. The primary references have been discussed already. Honda reveals adding aromatic perfume to lubricating oil to negate malodor in the exhaust gas. Hitachi displays a blend of lubricating oil and fragrance to avoid bad smell when the blend is heated. It would have been obvious to one having ordinary skill in the art, at the time the invention was made, to add a scent to the lubricating oil, in order to avoid malodor when said oil becomes hot.

11. St. Clair et al. 3,772,196 and Chiu et al. 2003/0186824 are enclosed to prove that the same material can perform as a thickener or as a pour point depressant or as a viscosity index improver. The French Patent submitted by applicants (FR 2,131,111) makes the same point. The terms are not contradictory.

***Conclusion***

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Szekely whose telephone number is (571) 272-1124. The examiner can normally be reached on 7:00 a.m.-5:30 p.m. Tuesday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Peter Szekely  
Primary Examiner  
Art Unit 1714

P.S.  
2/2/05